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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/010,193	01/21/98	GARRISON	33500-00004

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EXAMINER

ROMAIN, J

ART UNIT	PAPER NUMBER
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2163

20

DATE MAILED: 11/21/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/010,193

Applicant(s)
Garrison t al.

Examiner
Romain Jeanty

Group Art Unit
2163

☒ Responsive to communication(s) filed on Aug 31, 2000

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) 1-7, 11, 13-15, 19-31, and 35-50 is/are pending in the applicat

Of the above, claim(s) _____ is/are withdrawn from consideration

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-7, 11, 13-15, 19-31, and 35-50 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s) _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

1. The finality of the prior Office action is withdrawn and a new Office action follows based on newly discovered prior art. Accordingly claims 1-7, 11, 13-15, 19-31, and 35-50 remain pending in the application.

Claim Rejections - 35 USC § 112

2. Claim 49 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 49 recites the limitation "the alteration rules". There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 U.S.C. § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was

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made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-6, 19-24, 27-29, 35, 37-38, 40-42, 44, 46 and 50 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Chang et al.** (Patent No. 5,884,288) in view of **Sharpe et al.** (Patent No. 5,222,018).

As per claims 1, 35, 41, most computers comprise a readable medium and a computer programming (software) for facilitating reading data from a computer microprocessor.

Chang discloses a method and system for electronic bill payment comprising receiving payments payors payment information (col. 2, lines 39-44) which reads on "Receiving respective sets of payment requests electronically from a plurality of independent sources, each set of payment requests corresponding to an associated set of payors requesting payments to a plurality of payees."

A network (col. 2, line 38).

Processing the payment requests (col. 9, lines 13-54) which reads on "Processing the payment requests at a single remittance processing system having a database including payee information for each of the plurality of payees to generate payment directions for paying the plurality of payees in accordance with the processed payment requests."

Chang discloses all the limitations above, but Chang fails to explicit disclose the step of generating payment directions for paying the plurality of payees in accordance with the processed payment requests. Sharpe discloses a system ~~of~~^{for} centralized

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processing of accounting and payment functions which recites issuing payment directions (col. 4, lines 31-48). It would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention to combine Chang with Sharpe because it would Chang the capability of ensuring that payments are correctly directed to the intended payees.

As per claims 2, 3, 21 and 42 while Chang fail to recite a "first, second, and a third format", it is noted that Chang teaches ensuring proper payment format (col. 9, line 1-12). Therefore, it is the examiner's position that receiving the payments in "first, second, and the third format" operates in the same manner as receiving payments in the proper payment format. The step of normalizing the first payment request to correspond to a normalized format and generating the payment direction based upon the normalized first payment requests formal payment would have been obvious to a skilled artisan in order to create a more efficient and effective method of processing the payment requests into a single standard format.

As per claims 4, 20 and 44, Chang fails to explicitly disclose receiving payment requests as a batch file. Official Notice is taken that receiving and sending request information in batch file is old and well known in the data processing art. It would have been obvious to a skilled artisan at the time of the applicants's invention to include this well known feature into the disclosure of Chang for the purpose of saving processing time.

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As per claim 5, Chang further discloses the step of performing one of electronically crediting a bank account of the payee and generating a check payable to the payee in accordance with the payment directions (col. 2, lines 53-58).

As per claims 6, 23-24 and 46, Chang fails to explicitly disclose generating a payment advice, and transmitting the payment advice to each of the plurality of payees. Official Notice is taken generating and transmit payment advice from a customer to a merchant old and well known in the art in the electronic commerce art. It would have been obvious to a skilled artisan in the at the time this invention was made to include this well known feature into Change in order to communication payment request information from a customer to a merchant.

As per claims 19 and 50, Chang disclose an electronic bill payment system for processing payment requests a plurality of payors comprising:

An input port for receiving payor payment requests from a plurality of separate sources (col. 2, 39-44 and lines 64-67).

A database configured to store records associated with a plurality of payees (col. 5, lines 44-49); and

A Processor for processing payors payment requests (col. 2, lines 49-58; col. 5, line 60 and col. 9, lines 13-54) which reads on "a processor for processing the payment requests for paying plurality of payees in accordance with the received payment requests and the records stored in the database associated with the plurality of payees." Chang discloses all the limitations above, but Chang fails to explicit disclose the step of generating payment directions for paying the plurality of payees. Sharpe discloses a

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system for centralized processing of accounting and payment functions which recites issuing payment directions (col. 4, lines 31-48). It would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention to combine Chang with Sharpe because it would ensure that payments are correctly directed to the intended payees.

As per claim 22, Chang discloses a merchant payment unit for paying the payees based on the payment directions by performing one of electronically crediting an account of the payee with a financial institution and generating a check or draft payable to the payee (col. 2, lines 51-58).

As per claim 27, Chang discloses wherein the processor is further configured to direct a payment to the payee in accordance with the payment directions (col. 4, lines 46-51).

As per claims 28 and 40, Chang discloses one of the payer payment requests to pay one of the plurality of payees having a plurality of payment remittance centers, the one payor payment request includes a payor account number with the one payee and the processor is further configured to process the account number to identify one of the plurality of payment directions to direct payment to the payment remittance center (col. 4, lines 1-11 and lines 37-43).

As per claim 29, Chang discloses a processor configured to identify information in the account number which corresponds to the one payment remittance center and to identify the one payment remittance center based upon the identified information (col. 6, lines 62 to col. 7, line 15).

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As per claims 37 and 38, Chang fails to explicitly disclose accessing his database. Official Notice is taken that accessing databases is old and well known in the data processing art for retrieving and matching of information. It would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention to access the database of Chang for obtaining information such an eleven digit zip code or any other information.

5. Claims 7, 25-26, 36 and 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Chang et al.** (Patent No. 5,884,288) in view of **Sharpe et al.** (Patent No. 5,222,018), and further in view of **Pintsov et al.** (Patent No. 5,612,889).

As per claims 7, 25, 36 and 47, Chang fails to explicitly disclose an eleven digit zip code. Pintsov discloses a mail processing system which teaches an eleven digit zip code (Col. 7, lines 49-52). It would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention to combine this type of eleven digit zip code into the Chang's electronic bill payment system. Doing so, would enable Chang to deliver payment data to a user's specific address or location. Further, accessing the database to locate the payee information corresponding to the eleven digit zip code would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention for facilitating easy access to the information.

As per claim 26, Chang fails to explicitly disclose accessing his database. Official Notice is taken that accessing databases is old and well known in the data processing art for retrieving and matching of information. It would have been obvious to a person of

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ordinary skill in the art at the time of the applicant's invention to access the database of Chang for obtaining information such an eleven digit zip code or any other information.

6. Claims 11, 30 and 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Chang et al.** (Patent No. 5,884,288), in view of **Sharpe et al.** (Patent No. 5,222,018), as applied to claim 1 above, and further in view of **Mersky et al** (Patent No. 6,119,106).

As per claims 11, 30 and 48, Chang fails to explicitly disclose identifying one or more alphanumeric characters in the account number. Mersky discloses a system for facilitating customer payments to creditors wherein an alphanumeric character is identified in an account number (col. 9, lines 8-32). It would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention to combine the teachings of Chang and Pinttsov with Mersky because it would provide Chang the capability to identify a payment document request. Further selecting one of the plurality of remittance centers based upon the identified alphanumeric characters and directing payment to the one remittance center would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention for the motivation of ensuring that the payment information is sent to the designated remittance center.

7. Claims 13-14 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Chang et al.** (Patent No. 5,884,288), in view of **Sharpe et al.** (Patent No. 5,222,018), as applied to claim 1 above, and further in view of **Anderson et al.** (Patent No. 6,021,202).

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As per claims 13 and 39, the combination of Chang and Sharpe fails to explicitly disclose storing alteration rules corresponding to a payee account number format. Anderson discloses a method and system for processing electronic documents which recites alteration rules.... (col. 10, line 55 to col. 11, line 13). It would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention to include the alteration rule of Anderson into Chang. Doing so, would enable Chang to ensure that a payor's account number is in compliance when making a payment request to a payee. Transforming the account number included in one of the payment requests into an altered account number including a portion of the at least one of a payor's street address and a payor's zip code according to the alteration rules would have been obvious to a skilled artisan in order to retrieve the payor's account information.

As per claim 14, the combination of Chang, Sharpe and Anderson fails to explicitly disclose transmitting the altered account number to the payee to notify the payee of a payment based on the payment directions. Transmitting the altered account number to the payee to notify the payee of a payment based on the payment directions would have been obvious to a person of ordinary skill in the art for the motivation of informing the payee of his account number's conformance with regard to a payment request.

8. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Chang et al.** (Patent No. 5,884,288), in view of **Sharpe et al.** (Patent No. 5,222,018), in view of **Anderson et al.** (Patent No. 6,021,202) and further in view of **Hilt et al.** (Patent No. 5,465,206).

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As per claim 15, the combination of Chang, Sharpe and Anderson fails to disclose storing validation rules corresponding to payee values for filed of the account number, and determining if the received account number conforms with the validation rules. Hilt discloses an electronic bill payment system which discloses validation rules corresponding to payee values.... (col. 15, lines 40-55 and col. 21, line 41 to col. 22, line 1). Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention to incorporate the validation rule of Hilt into Chang. Doing so, would enable him to provide a much safer payment system to consumers.

9. Claim 49 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Chang et al.** (Patent No. 5,884,288), in view of **Sharpe et al.** (Patent No. 5,222,018), in view of **Anderson et al.** (Patent No. 6,021,202) and further in view of **Hilt et al.** (Patent No. 5,465,206).

As per claim 49, the combination of Chang, Sharpe and Anderson fails to disclose storing validation rules corresponding to payee values for filed of the account number, and determining if the received account number conforms with the validation rules. Hilt discloses an electronic bill payment system which discloses validation rules corresponding to payee values.... (col. 15, lines 40-55 and col. 21, line 41 to col. 22, line 1). Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention to incorporate the validation rule of Hilt into Chang. Doing so, would enable Chang to provide a much safer payment system to consumers. Further, transforming the account number included in one of the payment requests into an altered account number including a portion of the at least one of a payor's street

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address and a payor's zip code according to the alteration rules would have been obvious to a skilled artisan in order to retrieve the payor's account information. Further, the combination of Chang, Sharpe and Anderson fails to explicitly disclose transmitting the altered account number to the payee to notify the payee of a payment based on the payment directions. Furthermore, transmitting the altered account number to the payee to notify the payee of a payment based on the payment directions would have been obvious to a person of ordinary skill in the art for the motivation of informing the payee of his account number's conformance with regard to a payment request.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Sharpe et al. (5,222,018) disclose a system for centralized processing of accounting and payment functions.

Landry (5,649,117) discloses a system and method for paying bills and other obligations including a selective payor and payee controls.

Landry (5,956,700) discloses a system and method for paying bills and other obligations including a selective payor and payee controls.

Kravitz (6,029,150) discloses a payment and transactions in electronic commerce system where customers request payments to be made to merchants.

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Schlect et al. (6,035,285) disclose an electronic bill presenting methods and bill consolidating methods which processes bill payment requests in different formats.

Remington et al. (6,070,150) disclose an electronic bill presentment and payment system for receiving payment request and payment instructions from customers.

Conclusion

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Romain Jeanty whose telephone number is (703) 308-9585. The examiner can normally be reached on weekdays from 8:00 a.m to 4:30 p.m.

If attempts to reach the examiner are not successful, the examiner's supervisor, Tariq R. Hafiz, can be reached at (703) 305-9643.

The fax number for Formal or Official faxes to Technology Center 2700 is (703) 308-9051 or 9052. Draft or Informal faxes for this Art Unit can be submitted to (703) 308-5357.

Any inquiry of a general nature or relating to the status of this application should be directed to the group receptionist whose telephone number is (703)308-3900.

Romain Jeanty

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November 13, 2000.


TARIQ R. HAFIZ
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100

ATTACHMENT TO AND MODIFICATION OF
NOTICE OF ALLOWABILITY (PTO-37)

(November, 2000)

NO EXTENSIONS OF TIME ARE PERMITTED TO FILE CORRECTED OR FORMAL DRAWINGS, OR A SUBSTITUTE OATH OR DECLARATION, notwithstanding any indication to the contrary in the attached Notice of Allowability (PTO-37).

If the following language appears on the attached Notice of Allowability, the portion lined through below is of no force and effect and is to be ignored¹:

A SHORTENED STATUTORY PERIOD FOR RESPONSE to comply with the requirements noted below is set to EXPIRE **THREE MONTHS** FROM THE "DATE MAILED" of this Office action. Failure to comply will result in ABANDONMENT of this application. ~~Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).~~

Similar language appearing in any attachments to the Notice of Allowability, such as in an Examiner's Amendment/Comment or in a Notice of Draftperson's Patent Drawing Review, PTO-948, is also to be ignored.

¹ The language which is crossed out is contrary to amended 37 CFR 1.85(c) and 1.136. See "Changes to Implement the Patent Business Goals", 65 Fed. Reg. 54603, 54629, 54641, 54670, 54674 (September 8, 2000), 1238 Off. Gaz. Pat. Office 77, 99, 110, 135, 139 (September 19, 2000).